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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/275,941	03/25/1999	KENICHIRO SATO	Q53788	1435

7590

01/14/2003

SUGHRUE MOIN ZINN  
MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20037

EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/275,941

Applicant(s)

SATO ET AL.

Examiner

Taylor Victor Oh

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-3 and 5-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

### Final Rejection

#### The Status of Claims

Claims 1-3 and 5-9 are pending.

Claim 1 has been rejected.

Claims 2-3 and 5-9 have been objected.

#### Claim Rejections-35 USC 103

1. Applicants' argument filed 4/18/2002 have been fully considered but they are not persuasive.

Rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Ahlheim et al (Makromol. Chem. 193(3), p.779-797) .

The rejection of Claim 1 under 35 U.S.C. 103(a) as being unpatentable over Ahlheim et al (Makromol. Chem. 193(3), p.779-797) is maintained for the reasons of the record in paper no. 16.

### Response to Argument

2. The applicants argue the following issue:

1. there is no teaching in Ahlheim et al to change R<sub>3</sub> from methyl to hydrogen to increase the lipophilicity of Ahlheim et al 's compound and

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furthermore, there is no teaching in Ahlheim et al to modify the stereoisomer of Ahlheim et al ;

2. the compounds of present invention provide unexpectedly superior results in comparison to Ahlheim et al , thereby having the patentability of the present invention over Ahlheim et al ;

3. according to Mr. Sato's Declaration, the monomer compound of the present invention can be polymerized to obtain a resin and allows control of the molecular weight of the resin, whereas the compounds of Ahlheim et al having a different structure from the compound of the present invention cannot be polymerized, thereby failing to form a resin.

The applicants' argument have been noted, but these arguments are not persuasive.

First, with regard to the lack of teaching in Ahlheim et al to change  $R_3$  from methyl to hydrogen to increase the lipophilicity of Ahlheim et al's compound and no teaching in Ahlheim et al to modify the stereoisomer of Ahlheim et al , the Examiner has noted the argument. However, this is related to a homologue of Ahlheim et al's compound. It is well established that the substitution of methyl for hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. In re Wood, 582 F.2d 638, 199 U.S.P.Q. 137 (C.C.P.A. 1978); In re Hoke, 560 F.2d 436, 195 U.S.P.Q. 148 (C.C.P.A. 1977). Furthermore, if the person having an ordinary skill in the art had desired to decrease the lipophilicity of the Ahlheim et al's compound, it

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would have been obvious for the skillful artisan in the art to have changed R<sub>3</sub> being the methyl group to hydrogen.

In addition, the issue of the stereoisomer of Ahlheim et al is irrelevant since the claims are not directed to the matter of the stereoisomer, but directed to the compound claims.

Therefore, it would have been obvious for the skillful artisan in the art at the time of the invention made to have selected the claimed compounds from routine experimentations on the polymerization reaction of the compounds so as to optimize the reaction.

Second, concerning according to Mr. Sato's Declaration, the unexpected results of the compounds of present invention in comparison to Ahlheim et al, the Examiner has noted the argument. However, this is not a formal Declaration, but is related to an opinion Declaration under 37 CFR 1.132, which do not overcome a prima-facie case of obviousness. The Examiner recommends to applicants to file a formal Declaration concerning unexpected results involving a side-by-side-comparison table in order to overcome a prima-facie case of obviousness.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 703-305-0809. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2742 for regular communications and 703-305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



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January 13, 2003



ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600